No. -781

Supreme Court, U.S.
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SUPREME COURT OF THE UNITED STATES

October Term 1986

IN THE MATTER OF THE PATENT APPLICATION OF

RICHARD FOTLAND and JEFFREY CARRISH,

PETITIONERS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX

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IN THE

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Art Unit 235 Paper No. 29

Appeal No. 592-05 ljk
HEARD:
September 26, 1984

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Richard A. Fotland
and
Jeffrey J. Carrish

Application filed August 11, 1980, Serial No. 177,297. for the Reissue of Patent No. 4,155,093, granted May 15, 1979. Method and Apparatus for Generating Charged Particles.

Arthur B. Moore et al. for Appellants.

Primary Examiner - Stuart N. Hecker.

Before Bennett, Henon and Nusbaum, Examiners-in-Chief.
Bennett, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1 through 33.

A purely legal issue having been presented, no claim has been reproduced.

No references are relied on.

Appeal No. 592-05

The invention relates to a method and apparatus for the generation of ions in air.

Claims 1 through 33 stand rejected under 35 USC 251 as lacking a statutory basis for reissue. The examiner has succinctly stated his position on page 2 of his examiner's answer. We quote:

> "Although this reissue application was applied for (8/11/80) within two years of the parent patent (5/15/79), the attempt to convert this reissue application from a 'no defect' application to a 'broadening reissue' application was after the two, year period (8/19/81). The Examiner's position is that the conversion date (8/19/81) is the date appellants applied for a 'broadening reissue' application. At that time Appellants knew the original claims were patentable over the art of record and a 'no defect' application would not permit a reissue patent. The effect of using the 'no defect', reissue filing date for the converted 'broadening reissue' patent application would be to extend the two year statutory time period for Appellants to review their patent for defects and compare their patent protection to current developments in the field."

ARGUMENTS

Appellants liken the two year statutory period of 35 USC 251 to the equitable doctrine of laches. They argue that even though they broadened their claims outside of the two year statutory period, they pursued their broadened claims with due diligence without prejudice to a third party while furthering the public interest by assuring the issuance of an improved patent having a more definite and predictable scope of protection.

Furthermore, appellants argue that by filing a reissue application under 37 CFR 1.175(a)(4), a no defect reissue, within the two year statutory grace period, they came within the fact pattern of In re Doll, 57 CCPA 822, 419 F.2d 925, 164 USPQ 218 (1970). In Doll, a regular reissue application with claims broader than the original claims was filed within two years from the grant of the patent. Subsequently, after the two year period, appellant submitted claims of broader scope. The Board of Appeals said that claims broader than the original had to be applied for within two years. The CCPA recognized that 35 USC 251 provided a two year limitation on applying for a broadened reissue. They concluded that Doll *had* applied for a broadened reissue within the two year period, as required by the statute. This they said was all that was necessary to meet the statutory time limitation. The fact that other broad claims were applied for outside of the grace period did not bar the grant of a patent as the examiner and the Board of Appeals asserted.

OPINION

We sustain the examiner's rejection under 35 USC 251 for the reasons that he has presented in his answer.

Our decision turns on our conclusion that appellants filed no real application for reissue within the statutory grace period provided in 35 USC 251. A reissue application under 37 CFR 1.175(a)(4) is nothing more than a request for an advisory opinion from the Patent and Trademark Office. In re Dien, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); In re Bose, 687 F.2d 432, 215 USPQ 1 (CCPA 1982); In re Bose, 687 F.2d 432, 215 USPQ 1 (CCPA 1982). Appellants' attempted conversion of their application to a regular reissue application was outside of the statutory period.

The Doll case relied on by appellants is not in point because appellants did not have a timely filed broadened reissue application which was further broadened outside of the statutory period as in Doll. Appellants took no action within the two year period which would entitle them to a real examination of their application. Appellants did nothing more during the two year period than request an advisory opinion from the Patent and Trademark Office. We agree with the examiner's conclusion that appellants' claims lack a statutory basis for reissue.

Accordingly, the decision of the examiner is affirmed.

AFFIRMED

Rodney D. Bennett, Jr. Examiner-in-Chief	)	
Paul J. Henon, Jr. Examiner-in-Chief	)	BOARD OF APPEALS
Mark E. Nusbaum Examiner-in-Chief	)	

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